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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/146,259 09/03/98 YOSHIDA

T 028433-007

EXAMINER

021839 TM21/0906  
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TREATY UNIT W

PAPER NUMBER

2183  
DATE MAILED:

09/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/146,259

Applicant(s)

Yoshida et al.

Examiner

W. TREAT

Group Art Unit

2183

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 (three) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 8/6/01

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. Claims 1-25 are presented for examination.
2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The fact that certain capabilities are provided to the invention by the format of the VLIW instruction while other capabilities are provided by the format of the sub-instructions of the VLIW instruction is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).
4. Applicants' claims mix the capabilities of instructions and sub-instructions without distinguishing as to what provides the capabilities and implying applicants have some form of hybridized instructions which are not enabled.
5. Applicant's arguments filed 7/6/01, paper no. 12, have been fully considered but they are not persuasive.

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6. Applicants argued: "In particular, Figure 8 clearly shows instructions I01, I11, I21, I31, I41, I51, and I61. Furthermore, Figure 9 discloses the timing for these instructions. Also, Figure 2 shows the CD field 403 which corresponds to the field for designating timing. In Figure 9, instruction I01 is decoded at cycle T2. ...
7. Applicants incorrectly refer to I01, I11, I21, I31, I41, I51, and I61 as instructions in their arguments. In applicants' specification, page 50, lines 5-12, it is made clear they are sub-instructions. Applicants incorrectly identify the CD field as 403 when in Figures 2(a) and 2 (b) it is identified as either 404 or 405 or 406. Also, Applicants' specification on page 21, line 26 through page 23, line 2 makes clear the CD fields are attached to the operations/sub-instructions not the instruction. The examiner interprets this to mean that the capabilities associated with the CD fields are properties of the sub-instructions and not the instructions. On page 50, line 18 of applicants' specification I01 is clearly identified as a sub-instruction.
8. Applicants claims are inconsistent with the definitions and descriptions set forth in applicants' specification. The 112, 1st paragraph rejection of claims 1-25 is maintained for these reasons.

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9. Claims 1-25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holmann et al. (Patent No. 5,815,698).

10. As noted in the examiner's previous action, applicants' severe 112 problems make it unclear how to best apply Holmann. However, in light of applicants' continuing 112 problems, the examiner maintains the rejection.

11. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing. In applicants' claim 14 and its dependent claims 18 and 20, applicants recite a first, second, third, and fourth register provided for specific purposes, but these appear nowhere in applicants' drawings. In those same claims applicants claim many determinations are made based on the data in those registers and other elements and describe a specific sequence of events and timing relationships based on the data and determinations. The same holds true for other of their claims. If applicants will merely point out how their drawings clearly depict all the elements, determinations, and timing relationships of claim 14 and its dependent claims 18 and 20, the

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examiner will withdraw this requirement. Otherwise, the examiner will persist in the requirement.

12. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the material set forth in the examiner's previous action as well as that designated in paragraph 11, *supra*, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

13. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

14. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication should be directed to William M. Treat at telephone number (703) 305-9699.

A handwritten signature in black ink, appearing to read 'Wm M Treat', with a stylized flourish at the end.

**WILLIAM M. TREAT  
PRIMARY EXAMINER**